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To: SPE Paula Bradley
Examiner Xuong My Chung Trans

Fax No.: 1-703-872-9306

From: Corinda Humphrey, Assistant to Richard P. Berg

Date: June 23, 2004

Re: Copy of Papers submitted to USPTO for USSN 09/247,795

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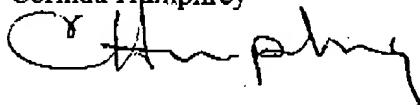
JUN 23 2004

OFFICIAL


Total Number of Pages: 8

Following please find a copy of the response to office action filed with the USPTO on April 22, 2003 in response to the office action dated January 22, 2003 and the postcard receipt stamped by the USPTO. Please reinstate this application

Sincerely,
Corinda Humphrey



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TO: <u>E.P.B./ch</u>	OUR REF: <u>616923-4</u>
FROM: COMMISSIONER OF PATENTS AND TRADEMARKS	DATE MAILED <u>4-22-03</u>
THE PATENT AND TRADEMARK OFFICE MAIL ROOM STAMP HEREON ACKNOWLEDGES RECEIPT OF: <u>Office Action</u> <u>Response</u> <u>(6 pages)</u>	
IN CONNECTION WITH: _____	STAMP 
SERIAL NUMBER <u>09/247,795</u>	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Pascal Oudet)	Group Art No.: 2181
Application No:	09/247,795)	Examiner: Xuong My Chung
)	Trans
Filed:	2/8/1999)	Re: RESPONSE
For:	"Address Remapping for a Bus")	Our Ref: B-3604 616923-4
)	Date: April 22, 2003

Commissioner for Patents
POB 1450
Alexandria, VA 22313-1450

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Dear Sir:

This paper is filed in response to the Office Action dated January 22, 2003.

First, it is noted for the record that this is the sixth non-final official action to issue in this application. To date, no RCE's have been filed and only certain ones of the claims have been amended, very minimally, to correct minor clarity issues. It is hoped that with this response examination on the merits can be concluded.

The Examiner made objections to the drawings under 37 C.F.R. 1.83(a). The objections under 37 C.F.R. 1.83(a) are, with all due respect to the Examiner, are not meritorious. The Examiner basically asserts in paragraph 3 of the official action that the "address detecting means" and "address remapping means" are not shown in the drawings. This is incorrect. In Figures 2 and 5 of the application the Examiner will find in blocks labeled "start detecting means" which is also identified with the reference numeral 30. At page 13, lines 10-11 of the application the Applicant states "the start detecting means of Figures 2 and 4 thus actually constitute address detecting means for the I2C bus." The Examiner's assertion that there is no "address detecting means" shown in the drawings is not correct.

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With respect to the Examiner's assertion that there is no "address remapping means" shown in the drawings, the Examiner's attention is directed to the bit setting means (51, 34) the switch (26) and the control means (32) shown in Figure 5. These elements constitute a bi-directional implementation of the "address remapping means" as is described at page 12, lines 13 -32 of the specification. A one-way embodiment is illustrated in Figure 2. Please also see the discussion of Figure 5 at page 12, lines 16-28.

Turning now to the rejection of claims 1-19 under 35 U.S.C. 103 over Blackledge et al. in view of Garbus et al. The Examiner agrees that Blackledge does not disclose a "bi-direction address translation." On the other hand, the Examiner asserts that Garbus discloses such a "bi-directional address translation." From that point, the Examiner asserts that it would be obvious to one of ordinary skill in the art to "include the teachings of Garbus in the Blackledge system in order to provide a bi-direction address translation." Apparently the motivation for doing this is because "both deal with the same address translation art."

With all due respect to the Examiner, this is nonsense. Why would a person of ordinary skill in the art modify Blackledge to use bi-directional address translation? Surely the Examiner must agree that providing bi-directional address translation involves an added complication to the Blackledge system in order to incorporate bi-directional address translation into it. Persons of ordinary skill in the art do not complicate the designs of systems for no reason. It just results in increased costs with no benefit. So, what is the benefit of making the modification to Blackledge which the Examiner asserts would be obvious to one of ordinary skill in the art to do? The Examiner asserts that the rationale is because "both deal with the same address translation art." Of course, that is not motivation and, moreover, the Examiner's assertion is not correct. The Examiner has already agreed that Blackledge does not involve bi-directional address translation whereas Garbus does. Obviously, the two of them do not deal with "the same address translation art." They involve different address translation arts.

With all due respect to the Examiner, the Examiner has not provided an appropriate rationale for combining the teachings of Blackledge and Garbus in the manner

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suggested in the official action.

Furthermore, even assuming that the Examiner could develop a rationale for combining the teachings of the two references, the combined teaching still fails to meet the claims. This was discussed at length in the response to the official action transmitted to the USPTO on December 20, 2002. Given the fact that the Applicant has gone to the effort to describe the limitations which cannot be found in the cited references, the Examiner should either withdraw the rejection or explain how she believes the limitations are anticipated by the cited documents.

If the Examiner believes that the prior art teaches each and every limitation of the claims, then the Examiner has the obligation to identify, with specificity, where the limitations can be found in the prior art. The Examiner has been previously requested to comply with 37 C.F.R. 1.104(c) in this regard. See, for example, the response dated April 11, 2002. The Examiner's failure to comply with 37 C.F.R. 1.104(c) is one of the reasons why Applicant is now responding to a sixth non-final official action. The Examiner has been requested in the past to comply with 37 C.F.R. 1.104(c) and that request is reiterated herein.

In part 7 of the official action the Examiner rejects, for the first time, claims 1, 4, 10, 13, 16 and 18 under 35 U.S.C. 102 as allegedly being anticipated by US Patent No. 5,636,216 to Fox et al. This grounds for rejection is respectfully traversed.

Turning to the merits of the Examiner's rejection, claim 1 is directed to "a bus." In the official action the Examiner asserts that Fox discloses in Figures 1 and 2 "network bus means." If the word "bus" can be found anywhere in the Fox patent either in the drawings or in the written disclosure thereof, the Examiner is requested to identify, with specificity, where the word can be found. If the word cannot be found in the Fox patent, just what element thereof is the Examiner reading on the word "bus"? The Examiner moves on to assert that Fox has a "first section bus and a second section bus." Where is that found in Fox? As already indicated, Fox does not appear to include the word "bus" in its disclosure, so just what elements are the Examiner reading on "bus"

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and then just what element is the Examiner attempting to read on "a first section bus" and "a second section bus"? With all due respect to the Examiner, it is not up to the Applicant to speculate what is in the Examiner's mind when applying the reference against the claims. It is the Examiner's obligation to explain, with specificity, just how a claim is allegedly anticipated. 37 C.F.R. 1.104(c) requires that when "a reference is complex or shows or describes inventions other than that claimed by the Applicant, the particular part relied upon must be designated as nearly as practicable." In making the rejection based upon Fox, the Examiner violates 37 C.F.R. 1.104(c). In addition to the elements of claim 1 which have been discussed in the immediately preceding paragraphs, claim 1 also recites that "sections on each section of the bus are each assigned a dummy address for being addressed by a station on the other section..." In the Examiner's analysis at the top of page 5 of the official action, it is noted that nowhere does the Examiner talk about stations nor about dummy addresses. Just how does the Examiner apply the Fox reference to allegedly anticipate these elements of the claim much less the claim as a whole? Claim 1 also recites "an address remapper defining two sections in the bus..." The Examiner, in making the rejection, never specifically addresses "an address remapper" but does talk about address mapping. But in doing so, the Examiner refers to elements 10, 14 and 22 in Figures 1 and 2 of the Fox patent. Well, if elements 10, 14 and 22 make up address mapping, then where is there a "address remapper defining two sections in the bus" as specifically required by claim 1? It is a mystery to try to figure out how the Examiner reads Fox on claim 1 in spite of the fact that the rules of practice require the Examiner to identify "as nearly as practicable" the particular part relied upon in the prior art reference.

The prosecution of patent applications is not supposed to be a pea and shell game in which the Applicant has to guess where the pea is. The Examiner has basically asked the Applicant to play a pea and shell game during the six official actions which have issued with respect to this application and, in spite of Applicant's continued request that the Examiner make clear her position for rejecting the claims, the Examiner appears to deem it appropriate to continue doing so. With all due respect to the Examiner, the Examiner is being unfair to Applicant and the Applicant objects to the way this application is being handled by the USPTO.

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It is apparent that the Examiner is trying to read claim 1 on prior art Internet gateway. It is not understood how claim 1 could possibly be read on such a prior art device. In particular, how is an Internet gateway supposed to anticipate "...stations on each section of the bus are each assigned a dummy address for being addressed by a station on the other section..." as recited by claim 1, for example?

Turning to part 8 of the official action, the Examiner's comments with respect to whether address translation in Blackledge is transparent or not is, with all due respect to the Examiner, disingenuous. Claim 18 requires that "each station on each section of the bus is assigned a dummy address by the remapper for the purpose of being addressed by a station on the other section..." Obviously, claim 18 envisions bi-directional address translation. The Examiner agrees on page 3 of the official action that Blackledge does not disclose bi-directional address translation or in the terms of the claim "the address remapper transparently remapping each dummy address from one section of the bus onto a physical address on the other section..."

With respect to the Examiner's commentary regarding the motivation to combine references, the Examiner's commentary, with all due respect, misses the point. The problem is that the Examiner has provided no motivation whatsoever for making the combination which she proposes. Indeed, it would seem from the official action, that the Examiner takes the viewpoint that she does not have to show any motivation for trying to combine the teachings of Blackledge and Garbus. That is not correct.

Finally, in the past, the Examiner has taken the position that certain elements were inherent in a disclosure. If the Examiner is of a mind to assert that Fox teaches something inherently, then the Examiner is reminded that 37 C.F.R. 1.104(d)(2) requires that when "a rejection in an application is based upon facts within the personal knowledge of an employee of the office, the data shall be as specific as possible and the reference must be supported when called for by the Applicant, by an Affidavit of such employee..." The Applicant wishes to take this opportunity to advise the Examiner that should the Examiner base any rejection on "facts within the personal knowledge of an employee of the office" that the Affidavit required by the aforementioned rule be

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provided.

Reconsideration of this application as amended is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents
POB 1450, Alexandria, VA 22313-1450 on

April 22, 2003

(Date of Deposit)

Corinda Humphrey

(Name of Person Signing)

(Signature)

April 22, 2003

(Date)

Respectfully submitted,



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